

Serial No.: 09/929,769
Filed: August 14, 2001
Reply to Office Action of July 14, 2003

REMARKS

Claims 1-15 remain pending in the present application. Applicants have amended the specification as shown above to correct the reference to priority claims, to supply the appropriate designations for registered trademarks that appear throughout the specification and to correct obvious misspellings. Applicants have also amended Claims 3-7 and 12-15 to change the claim dependency recited therein. These amendments add no new matter.

Priority, Oath/Declaration and Specification Issues

The Examiner first asserts that the present application does not satisfy the requirements for obtaining priority under 35 U.S.C. §§ 119 and 120 to the various priority documents listed in the original filing papers.

In this regard, Applicants first note that the Examiner correctly asserts that SEQ ID NO:7 of the present application is disclosed in U.S. Provisional Application Serial No. 60/119,537 (filed on February 10, 1999) and PCT/US99/28551 (filed on December 2, 1999). Applicants also note, however, that the Examiner incorrectly asserts that SEQ ID NO:7 of the present application does not appear in the specification of PCT/US99/28634 (filed on December 1, 1999). In fact, current SEQ ID NO:7 does appear in the specification of PCT/US99/28634 (see, e.g., Figure 14 of PCT/US99/28634). In summary, therefore, the amino acid sequence disclosed in the present application as SEQ ID NO:7 and referred to in the currently pending claims is also disclosed in (1) U.S. Provisional Application Serial No. 60/119,537 filed on February 10, 1999, (2) PCT/US99/28634 filed on December 1, 1999 and (3) PCT/US99/28551 filed on December 2, 1999.

The remaining 17 priority claims listed in the original filing papers provide support for inventions disclosed in the present specification, but which are no longer being claimed as a result of amending the originally filed claims in response to the Restriction Requirement (Paper No. 7) mailed herein on April 9, 2003. As such, Applicants herein have amended the specification to delete priority claims to applications that do not disclose the currently recited SEQ ID NO:7. The amended priority claim made herein also correctly indicates the proper relationship of the applications to one another.

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Also, Applicants enclose herewith a Petition to Correct Inventorship under 37 C.F.R. § 1.48(a) (and certain papers associated with this petition) which serve to add the following persons as inventors of the presently claimed subject matter; Audrey Goddard, Austin Gurney, Colin Watanabe, and William Wood. Furthermore, as a result of amending the original claims in response to the Restriction Requirement (Paper No. 7) mailed herein on April 9, 2003, the following persons originally named as inventors in this application should now be deleted as named inventors; Paul Polakis, Jianyong Shou, Victoria Smith, Robert Soriano, P. Mickey Williams, Thomas D. Wu and Zemin Zhang. In summary, the proper inventorship for the presently claimed invention is as follows; Wei-Qiang Gao, Audrey Goddard, Austin Gurney, Colin Watanabe, and William Wood. The enclosed substitute declaration and application data sheet provide the correct inventorship and priority information and Applicants respectfully request the issuance of an amended filing receipt evidencing the herein amended and corrected priority and inventorship information.

The Examiner also objects to the specification due to the alleged existence of improperly demarcated trademarks and certain misspellings in the specification. Applicants have herein amended the specification to make the appropriate corrections.

The Objection to Claim 14

The Examiner objects to Claim 14 as allegedly not further limiting the subject matter of a previous claim. Specifically, the Examiner asserts that the recitation in Claim 14 that the claimed antibody "induces death of a cell to which it binds" does not further limit the subject matter of Claim 1 as such would allegedly be an "inherent property" of all antibodies falling within the scope of Claim 1. Applicants respectfully disagree.

Claim 1 is directed to antibodies that bind to certain polypeptides that have been shown in the present specification to be overexpressed on the surface of prostate cancer cells as compared to normal prostate cells. However, nowhere in Claim 1 is recited the requirement that such antibodies induce the death of a cell to which they bind. In other words, Claim 1 encompasses both (1) antibodies that bind to the recited polypeptides on a cell and kill that cell, and (2) antibodies that bind to the recited polypeptides on a cell without killing that cell. In other words, not every antibody

(as defined in the present specification for example at page 26, line 29 to page 30, line 23) would induce the death of a cell to which it binds. It is well known in the art that the binding of an antibody to a cell surface protein does not automatically and necessarily result in the death of that cell. Such "non-killing" antibodies would find use, for example, in the diagnostic and quantitative detection of expression of the recited polypeptide.

In summary, therefore, the ability to induce the death of a cell to which it binds is not an inherent property of all of the antibodies falling within the scope of Claim 1. Claim 14 is proper, therefore, in that it further limits the subject matter of Claim 1.

The Rejections under 35 U.S.C. § 112, First Paragraph

The specification is objected to and Claims 1-15 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to provide an adequate written description of the claimed invention and allegedly failing to provide an enabling disclosure.

First, the Examiner asserts that Claims 1-15 are, in part, directed to antibodies that bind to a polypeptide having a certain degree of sequence identity to an amino acid sequence encoded by a cDNA sequence deposited with the American Type Culture Collection under ATCC Accession No. 230651. The Examiner goes on to indicate that to satisfy the requirements of 35 U.S.C. § 112, first paragraph, and thereby obviate this rejection, Applicants are required to submit an affidavit or declaration assuring that (1) restrictions upon public access to the deposited material will be irrevocably removed upon the grant of a patent on the present application, and (2) that the deposited material will be replaced if viable samples cannot be dispensed by the depository.

Initially, Applicants respectfully direct the Examiner to the present specification at page 111, lines 23-32, where Applicants have already provided these assurances and have indicated that the deposit was made under the provisions of the Budapest Treaty. Such should be sufficient to obviate this rejection. In the interest of furthering the prosecution of this application, however, the undersigned attorney of record (who has authority and control over the conditions of deposit of the material deposited with the ATCC under Accession No. 230651) submits herewith a declaration again providing the various assurances requested by the Examiner. It is believed that submission

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of this declaration is sufficient to obviate the present rejection.

Secondly, the Examiner asserts that since the original filing papers indicate that the present application is a continuation of U.S. application Serial No. 09/888,257 (the '257 application) and the present application is not identical to the '257 application, a written description problem for the claimed subject matter exists. Applicants have herein amended the inventorship and priority claims for the present application and such amendment is believed to obviate this rejection.

In light of the above, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, first paragraph.

The Rejections under 35 U.S.C. § 102

Claims 1-9 and 13-15 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 00/36102 (corresponding to PCT/US99/28634). Moreover, Claims 1-9 and 13-15 stand rejected under 35 U.S.C. § 102(f) over U.S. Provisional Application Serial No. 60/119,537. In regard to these rejections, Applicants note that as evidenced in the enclosed papers which serve to amend the inventorship and priority claims for the present application, the present application validly claims priority to both PCT/US99/28634 and U.S. Provisional Application Serial No. 60/119,537 as cited by the Examiner herein. It is believed, therefore, that these rejections have been rendered moot.

The Rejections under 35 U.S.C. § 103

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 00/36102 (corresponding to PCT/US99/28634) in view of Fernandez et al. and/or U.S. Patent No. 5,208,020.

In regard to this rejection, Applicants again note that as evidenced in the enclosed papers which serve to amend the inventorship and priority claims for the present application, the present application validly claims priority to PCT/US99/28634. Moreover, neither Fernandez et al. nor U.S. Patent No. 5,208,020 disclose antibodies that bind to polypeptides having at least 80% sequence identity to SEQ ID NO:7 disclosed herein. As such, Applicants believe that the present rejection has

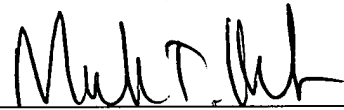
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been rendered moot

In light of the above amendments and remarks, Applicants believe that this application is now in condition for immediate allowance and respectfully request that the outstanding rejections be withdrawn and this case passed to issue.

The Examiner is invited to contact the undersigned at (650) 225-4461 if any issues may be resolved in that manner.

Respectfully submitted,
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